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MAILED

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In re Application of
Chris Buhr et al.
Application No. 09/408,396
Filed: September 29, 1999
Attorney Docket No. 8GSLIS-0128

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:
: THIRD ORDER TO
: SHOW CAUSE
:

CENTRAL REEXAMINATION UNIT

This is in response to the applicants' communication entitled Response To Second Order To Show Cause filed May 14, 2007, requesting that prosecution of the above-identified application be continued.

Applicants' response is before the Office of Patent Legal Administration (OPLA) for decision.

BACKGROUND

1. The present application ("present reissue proceeding") was filed September 29, 1999, for reissue of U.S. Patent No. 5,672,697 (the '697 patent), which issued September 30, 1997.
2. On March 23, 2006, in the present reissue proceeding, the examiner completed examination and prepared a Notice of Allowability for mailing that indicated that claims 1-26 (all of the claims) were allowable. Further, on March 23, 2006, the Notice of Allowability and a Notice of Allowance were mailed.
3. On April 20, 2006, the Technology Center Director withdrew the present application from issue. The issue fee had not been paid.
4. A review of the Office's financial records for the '697 patent reveals that the 3.5 year maintenance fee due and not paid could have been paid during the period from October 2, 2000 (September 30, 2000 was a Saturday) through March 30, 2001, or with a surcharge during the period from April 2, 2001 (March 31, 2001 was a Saturday) through October 1, 2001 (September 30, 2001 was a Sunday). As a result, the '697 patent expired after midnight on September 30, 2001, for failure to pay the 3.5 year maintenance fee due. See 1253 *Official Gazette* 1 (December 4, 2001). Further, the Office financial records reveals that had the delayed payment of the 3.5 year maintenance fee been accepted for the '697 patent, a payment of the 7.5 year maintenance fee due and not paid should have been paid during the period from September 30, 2004 through March 30, 2005, or with a surcharge during the period from March 31, 2005 through September 30, 2005.
5. On May 16, 2006, in the present reissue proceeding, an Order To Show Cause was mailed stating that the '697 patent had expired for failure to pay the first and second maintenance fees, the Director of the USPTO no longer had the authority under 35 U.S.C. § 251 to reissue the '697 patent, and the Office intended to terminate the present reissue proceeding and hold the application for reissue of the '697 patent to be an

- abandoned application. Applicants were given a period of 30 DAYS from the mailing of the ORDER to show cause why the Office should not terminate the present reissue proceeding.
6. In response, on June 6, 2006, in the present reissue proceeding, *inter alia*, a communication entitled Response To Order To Show Cause And Petition For Delayed Payment Of Maintenance Fees Pursuant To 37 CFR § 1.378(b) and an authorization to charge counsel's deposit account for any deficiency associated with the communication were filed. Applicants requested that prosecution of the application be continued as the owner of the '697 patent filed on June 6, 2006, in the '697 patent, the requisite first and second maintenance fees and surcharges along with a petition to accept late payment of the maintenance fees based upon the patent owner's unavoidable failure to timely pay the maintenance fees.
 7. On November 13, 2006, in the present reissue proceeding, a Second Order To Show Cause was mailed stating that the '697 patent had expired for failure to pay the first and second maintenance fees, the Director of the USPTO no longer had the authority under 35 U.S.C. § 251 to reissue the '697 patent, applicants' request that prosecution be continued was dismissed, and the Office intended to terminate the present reissue proceeding and hold the application for reissue of the '697 patent to be an abandoned application. The June 6, 2006 reply was held to be sufficient only to the extent that the Office would not terminate the present reissue proceeding at that time. Applicants were given a period of six months from the mailing of the Second Order to again show cause why the Office should not terminate the present reissue proceeding.
 8. In response, on May 14, 2007, in the present reissue proceeding, a Response To Second Order To Show cause has been filed. Applicants state that they just received, for the '697 patent, a decision dismissing the petition to accept delayed payment of the maintenance fee. The decision states that applicants are given a non-extendable two month period to request reconsideration, and that any request for reconsideration of the decision dismissing the petition in the '697 patent will require a gathering of facts and information. Applicants request that the proceedings in the present reissue proceeding not be terminated and that the period for reply which was set forth in the Second Order To Show Cause be extended.

DECISION

37 CFR 1.181(f) states, in part:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

This provision of the rules is a statement that there is no assurance that any petition filed will be granted. Action shall not be taken based upon an assumption of a future grant of a petition. In this instance, the mere filing of the June 6, 2006 petition for delayed payment of maintenance fees did not act to restore the '697 patent to status as a live patent. Further, on May 4, 2007, in the '697 patent, the petition for delayed payment of maintenance fees was dismissed. As such, the '697 patent remains in the status of an expired patent for failure to pay the first and second maintenance fees. Accordingly, the Director of the USPTO does not have the authority under 35 U.S.C. § 251 to reissue the '697 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392

(Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only for the unexpired part of the term of the original patent." Thus, **when Morgan's original patent expired** on August 19, 1992, **the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director does not have the authority under 35 U.S.C. § 251 to reissue the patent, at present, it remains proper that the Office terminate the present reissue proceeding, and thereafter hold the application for reissue of the '697 patent to be an abandoned application.

In view of the above, applicants' request that the prosecution of the above-identified application be continued is once again dismissed, and the May 14, 2007 response to the Second Order To Show Cause mailed November 13, 2006 is again found not to be sufficient to provide basis for examination of the application. The reply to the Second Order To Show Cause mailed November 13, 2006 is, however, sufficient to the extent that the Office will not terminate the present reissue proceeding at this time. Rather, based on the filing of the May 14, 2007 response, jurisdiction over the reissue proceeding is being retained in the Office of Patent Legal Administration (OPLA), to provide the applicants with an opportunity to provide a third showing of cause as to why the Office should not terminate the present reissue proceeding, as will be discussed in the below conclusion.

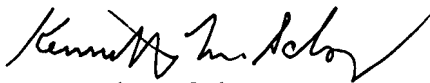
CONCLUSION

1. Applicants are hereby being provided with a period of **SIX(6) MONTHS** from the mailing of this **THIRD ORDER TO SHOW CAUSE** to again show cause why the Office should not terminate the present reissue proceeding. This period is being set to provide applicants an opportunity to file a renewed maintenance fee petition within the time set in the May 4, 2007 dismissal of the original maintenance fee petition, and for a decision by the Office on any such renewed maintenance fee petition.
2. If applicants propose to show cause why the present reissue proceeding should not be terminated, **applicants' showing must include** either:
 - A) A copy of a favorable determination on the merits of the June 6, 2006 petition to accept late payment of the first and second maintenance fees, or
 - B) An explanation of why the proceeding should not be terminated at that point in time even though the original patent has expired.

Applicants must also show due diligence when providing a response to this **THIRD ORDER TO SHOW CAUSE**. If applicants make a showing, the showing will be evaluated as to whether due diligence was exercised in providing the showing, and as to

whether the showing provides sufficient basis why the present reissue proceeding should not be terminated.

3. **Failure to respond to this THIRD ORDER TO SHOW CAUSE within the SIX (6) MONTH period that has been set in this decision will result in the proceeding being terminated by default.** If the present reissue proceeding is terminated by default, jurisdiction over the application for reissue of the '697 patent would then be returned to Technology Center Art Unit 1623 for processing as an abandoned application.
4. Jurisdiction over the file for reissue application 09/408,396 is being retained in the Office of Patent Legal Administration (OPLA), pending a response by applicants, or the expiration of time for a response.
5. Telephone inquiries related to this decision should be directed to Fred Silverberg, Senior Legal Advisor, at (571) 272-7719 or, in his absence to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy



Conferee: Fred A. Silverberg, Senior Legal Advisor